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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,161	09/21/2001	Christian H. Passow	355.00103 (2001P17280US)	4639

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WOOD, PHILLIPS, VanSANTEN,
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EXAMINER

LUEBKE, RENEE S

ART UNIT PAPER NUMBER

2833

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/961,161

Applicant(s)

PASSOW

Examiner

Renee S. Luebke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 4-8, 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 9, 10, 14 and 17-32 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. The drawings are objected to because in Fig. 1, it appears that "115" should be changed to -100-. Applicant's assertion that "115" references components of the contact block assembly 100 is not supported by the specification since reference numeral "115" is not found in the specification.

In addition, the reference numerals in all of the figures are handwritten, too small and indistinct. Because of this, the examiner has been unable to find a number of the reference numerals in the figures. Applicant is respectfully requested to confirm that all of the numerals used in the specification are present in the drawings.

New corrected drawings are required in this application because of the issues raised above. The requirement for corrected drawings will not be held in abeyance. Any response to this Office action that does not include legible, corrected drawings, with all reference numbers properly coinciding between the specification and the drawings, will be held non-responsive and may lead to the application being considered to be abandoned.

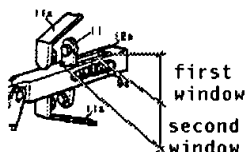
2. The disclosure is objected to as being inconsistent. In particular, the presence of a second movable contact (page 12, lines 3-4) is not consistent with the test and advantages illustrated in Figs. 6 and 7 and discussed in the remainder of the application as an important purpose of the invention. The presence of a second movable contact, arranged as indicated, would prevent incorrect insertion, thereby voiding the necessity and usefulness of a test.

3. Regarding claim 17, the word "means" is preceded by the words "recess" and "window" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function (only structure) is specified by the words preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Applicant argues that the function can and does follow the term means. While it is acknowledged that the function is permitted to follow the term, it is noted that in the present claims the terms denote structure. Any description that follows does not change that status. A function is something that is performed by a structure. It is not the structure itself. (For example, an opening means or an entering means is the function that a door performs. The term "door means" is indefinite because "door" is one structure for performing the function.) A function requires a verb (or something similar), not an adjective as suggested by applicant's remarks.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 9, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Reguant Soler. This pusher assembly comprises a body 7, a first window and a second window in a first portion of the body (see marked figure at left), a movable contact 11, and a spring 9a in a recess 12a.



Applicant argues that this device lacks a recess formed through the first end of the body portion. However, the recess 12a is at an end of the body 7. Lacking any other definition, this end is seen to be the first end. Since structure 12a is a void, that goes through the member, and is located in this first end, it is seen to be a recess through the first end of the body portion as claimed.

6. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Reguant Soler. This pusher assembly comprises a body 7 and a recess 12a. It is noted that the window through which the contact extends is both a first window means and a second window means since it performs both functions.

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It is further noted that recess 12a is open at the top of the end of the body portion.

7. Claims 25-32 remain rejected under 35 U.S.C. 102(b) as being anticipated by Ikeda. The method for assembling this pusher assembly comprises inserting a movable contact 12 into a first substantially vertical position (Fig. 4) in a first window (the left side), moving the contact to a second window (the right side) and rotating it into the horizontal operating position (Fig. 3). In addition, a spring 4 is inserted through a recess formed by the windows. In regard to claims 22 and 26, it is noted that the second window comprises a shoulder 7 against which the contact is retained. Contrary to applicant's assertions in regard to claim 25, as defined above there **are** two windows in this device. Contrary to applicant's assertions in regard to claim 30, Fig. 4 shows the movable contact in a **substantially** vertical orientation just after it has been inserted through the first window and prior to its rotation into a substantially horizontal position (shown in Fig. 3), as claimed.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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9. Claims 18-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 33, 35 and 37 of copending Application No. 09/961160. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to exclude the steps involving the second contact in a device where the second contacts is not necessary. It has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. In re Karlson, 136 USPQ 184. In regard to claim 24, it is noted that the determination of correct insertion is an inherent step in the method of assembling; at the latest, such a determination is made upon initial operation of the device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 1, 4-8, 15 and 16 are allowed.

In regard to claim 1, it is noted that although Reguant Soler does comprise a body portion having an open top and defining a recess for a spring (contrary to applicant's remarks), the prior art fails to show or teach such an arrangement where the movable contact is captured between that spring and a shoulder of the window.

12. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. It is suggested that responses to this final action be faxed to:

(703) 872-9319 or 308-7722, 308-7724

Please refrain from sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

For formal communications, please mark "EXPEDITED PROCEDURE."

For informal or draft communications please clearly label "PROPOSED" or "DRAFT."

Alternatively, responses may be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

For additional information regarding this new address, which was effective May 1, 2003, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

Hand-delivered responses should be brought to:

Crystal Plaza 4, Fourth Floor (Receptionist)

2201 South Clark Place, Arlington, Virginia.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mrs. Paula Bradley, can be reached at (703) 308-2319.



Renee S. Luebke
Primary Patent Examiner
July 27, 2003